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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,818	12/05/2003	Christopher Tzann-en Szeto	YHOOP009	8561

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EXAMINER

BAROT, BHARAT

ART UNIT PAPER NUMBER

2155

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,818

Applicant(s)

SZETO ET AL.

Examiner

Bharat N. Barot

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-41 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 19-41 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/10/2005.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. New claims 19-41 remain for further examination.

The new grounds of rejection

2. Applicants' presented new claims 19-41 and also presented arguments with respect to claims 19-41 filed on May 23, 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Drawings

3. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 19-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19, 31, and 39 contain the limitations (subject matters) the interface having two regions first one is automatically shared in real-time and second one is not

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automatically shared; and in response to a user input select, update, and store content/data to be shared in real-time, which were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 26 and 35 contain a limitation (subject matter) storing data that indicates online purchasing information related to the selected portion of content, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Other dependent claims, which are not specifically cited above are also rejected because of the deficiencies of their respective parent claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 19-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Verma et al (U.S. Patent No. 6,564,246). Verma's patent meets all the limitations for claims 19-41 recited in the claimed invention.

8. As to claim 19, Verma et al teach a method of sharing information in an instant messaging environment (See abstract; and figure 2), comprising the computer-implemented steps of: providing an instant messaging interface for a first instant messaging application and a second instant messaging application; the instant messaging interface including: a first region in which all content within the region is automatically shared in substantially real-time, and a second region in which content is not automatically shared; storing data that indicates a portion of content from the first instant messaging application that is to be shared in substantially real-time (figure 2; and column 10 lines 7-51); receiving input from a user of the first instant messaging application that selects a portion of content displayed within the second region of the instant messaging interface of the first instant messaging application; in response to the input, performing an update to the stored data based on the selected portion of content; and in response to the update to the stored data, causing the selected portion of content to be shared substantially in real-time in the second region of the instant messaging interface of a second instant messaging application (figures 3-4; and column 10 line 52 to column 11 line 19).

9. As to claim 20, Verma et al teach that storing data comprises storing data locally on the device running the first instant messaging application (figure 1; and column 9 line 49 to column 10 line 6).

10. As to claims 21-24, Verma et al teach that displaying search results in the second region of the instant messaging interface of the first instant messaging application based on search information entered by a user of the first instant messaging application, wherein the step of receiving input from the user of the first instant messaging application that selects a portion of content displayed within the second region of the instant messaging interface of the first instant messaging application comprises receiving input from the user that selects all of the displayed search results or a portion of the displayed search results, and wherein the step of storing data that indicates a portion of content that is to be shared comprises storing the search information entered by the user (figures 2-4; and column 10 line 7 to column 11 line 19).

11. As to claim 25, Verma et al teach that sending a notification from the first instant messaging application to the second instant messaging application that the stored data has been updated (figure 7; and column 11 line 57 to column 12 line 12).

12. As to claim 26, Verma et al teach that storing data that indicates a portion of content that is to be shared in substantially real-time additionally comprises storing data

that indicates online purchasing information related to the selected portion of content (figures 5-7; and column 11 line 20 to column 12 line 12).

13. As to claims 27-28, Verma et al disclose that the content is a list of categories; and teach that receiving from the user of the first instant messaging application a list of users permitted to share content, wherein the user of the second instant messaging application is in the list of users (figures 1-2 and 5-7; column 8 lines 36-64; column 9 line 62 to column 10 line 51; and column 11 line 20 to column 12 line 12).

14. As to claim 29, Verma et al teach that in response to the update to the stored data, causing the selected portion of content to be shared in substantially real-time in the second region of the instant messaging interface of a third instant messaging application (figures 2-3; and column 10 lines 7-61).

15. As to claim 30, Verma et al teach that the selected portion of content is first selected portion of content, and the stored data is first stored data, additionally comprising the steps of: storing second data that indicates a second portion of content that is to be shared in substantially real-time; receiving input from the user of the first instant messaging application that selects a second portion of content displayed within the second region of the instant messaging interface of the first instant messaging application; in response to the input, performing an update to the second stored data based on the second selected portion of content; and in response to the update to the

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second stored data, causing the second portion of content to be shared in substantially real-time in the second region of the instant messaging interface of a third instant messaging application; wherein the second portion of content is different from the first portion of content (figures 2-5; and column 10 line 7 to column 11 line 38).

16. As to claims 31-38, they are also rejected for the same reasons set forth to rejecting claims 19-21, 24, 26, and 28-30 above, since claims 31-38 are merely an apparatus for the method of operation defined in the claims 19-21, 24, 26, and 28-30.

17. As to claims 39-41, they are also rejected for the same reasons set forth to rejecting claims 19, 21, and 29 above, since claims 39-41 are merely a program product for the method of operation defined in the claims 19, 21, and 29.

Response to Arguments

18. Applicant's arguments have been fully considered. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

Additional References

19. The examiner as of general interest cites the following references.

- a. Shiigi, U.S. Patent No. 6,564,249.
- b. Appelman et al, U.S. Patent No. 6,539,421.
- c. Bly et al, U.S. Patent No. 5,220,657.

20. Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

Patent Examiner Bharat Barot

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August 11, 2005


BHARAT BAROT
PRIMARY EXAMINER